



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,007	08/17/2007	Kim A. Beazley	MONS:292US	1798

73905 7590 10/21/2011
SNR DENTON US LLP
P.O. BOX 061080
CHICAGO, IL 60606-1080

EXAMINER

KRUSE, DAVID H

ART UNIT	PAPER NUMBER
----------	--------------

1638

MAIL DATE	DELIVERY MODE
-----------	---------------

10/21/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/582,007	Applicant(s) BEAZLEY ET AL.	
	Examiner DAVID H. KRUSE	Art Unit 1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 5,9-12,14 and 24-36 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☒ Claim(s) 9-12,24,25 and 27-33 is/are allowed.
- 7) ☒ Claim(s) 5,14,26 and 34-36 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/22/2001 & 7/25/2011</u> . | 6) <input type="checkbox"/> Other: ____. |

STATUS OF THE APPLICATION

1. This Office action is in response to the Amendment and Remarks filed on 7 September 2011.
2. The objections to the claims are withdrawn in view of Applicants' amendments to the claims.
3. The rejections of record under 35 U.S.C. § 112, second paragraph, are withdrawn in view of Applicants' amendments to the claims.
4. The rejection of claims 10-12 are rejected under 35 U.S.C. § 112, first paragraph, is withdrawn in view of Applicants' response.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claim 26 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

At line 2, the phrase "comprising corn event MON88017" renders the claim indefinite because it is unclear if this phrase refers to the claimed composition or if it refers back to the corn plant, seed or parts thereof of claim 25. Hence, the metes and bounds of the claim are unclear.

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 1638

8. Claims 5, 14 and 34-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicants claim a transgenic glyphosate tolerant corn plant comprising SEQ ID NO: 1 and 2; and further comprising SEQ ID NO: 3 or 4, or both SEQ ID NO: 3 and 4.

Applicants describe a transgenic glyphosate tolerant plant comprising event MON898017 produced by random transformation. Applicants describe SEQ ID NO: 1 and 2 as being 20mer nucleotide sequences at the left and right borders of said event; and SEQ ID NO: 3 as comprising corn genomic DNA, SEQ ID NO: 1 and part of the rice actin 1 promoter; and SEQ ID NO: 4 as comprising part of the Hsp17 terminator, SEQ ID NO: 2 and corn genomic DNA (see Figure 2).

Applicants do not describe any other transgenic glyphosate tolerant corn plant comprising SEQ ID NO: 1, 2, 3 or 4, or combinations thereof.

Hence, it is unclear that Applicants were in possession of the invention as broadly claimed.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Strop *et al* (U.S. Patent 4,808,426).

The instant claim is found to be indefinite because the metes and bounds of the claim are unclear. For the purposes of the instant rejection, the claim is read as the claimed composition does not require corn event MON88017.

Strop *et al* teach a method of making a commodity product composition comprising corn oil at claim 23.

Strop *et al* does not teach using a corn plant part comprising corn event MON88017.

The instant claim would have been *prima face* obvious to one of ordinary skill in the art at the time of the instant invention because a commodity product composition comprising corn oil would have been obvious. The instant claim does not appear to set forth a non-obvious structure. Given the teachings of Strop *et al*, one of ordinary skill in the art would have had a reasonable expectation of success.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

Art Unit: 1638

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Claims 9-12, 24, 25 and 27-33 are allowed.

13. Claims 5, 14, 26 and 34-36 are rejected.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David H. Kruse, Ph.D. whose telephone number is (571) 272-0799. The examiner can normally be reached on Monday to Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached at (571) 272-0975. The central FAX number for official correspondence is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (571) 272-1600.

/David H Kruse/
Primary Examiner, Art Unit 1638
18 October 2011